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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,401	08/25/2000	Akiko Horiguchi	H&A-100	4524

24956 7590 10/14/2004

MATTINGLY, STANGER & MALUR, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/645,401

Applicant(s)

HORIGUCHI ET AL.

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07/13/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15 - 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/13/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

1. This action is in response to request for reconsideration filed on July 13, 2004. Original application contained Claims 1 – 14. Applicant cancelled claims 1 – 14 and added new Claims 15 – 22. Therefore, presently pending claims are 15 – 22.

***Response to Arguments***

2. Applicant's arguments filed on September 16, 2004, have been fully considered but they are not persuasive for the following reasons:

Regarding independent claim 8, applicant argued that the cited prior arts (CPA) [Deo et al U.S. Patent number 5,721,781] do not teach, suggest or disclose, "the certificate or an apparatus for issuing a certificate of the present invention in which the digital signature is generated from first information stored in electronic tag and second information printed on the surface of the certificate" and "the information described in the certificate is confirmed based on the information stored in the electronic tag and the digital signature printed on the certificate". These arguments are not found persuasive in view of new prior art Doggett et al (U.S. Patent Number 5,677,955). Doggett teaches a portable certificate (token) in which the digital signature is generated from the user's information and the information that is printed on the certificate (name, number, public

signature verification key) and Doggett also discloses that the information described in the certificate is confirmed based on the information stored in the electronic tag and the digital signature printed on the certificate (summary; Column 10 lines – 22 and Column 14 line 4 – Column 15 line 32).

Applicant clearly has failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts. Therefore, the examiner respectfully asserts that CPA does teach or suggest the subject matter broadly recited in independent claims 15 and 19. Dependent claims 16 – 18 and 20 - 22 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action. Accordingly, Claims 15 – 22 are rejected.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15 – 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Doggett et al (U.S. Patent Number 5,677,955).

Regarding Claim 15, Doggett teaches and describes a certificate comprising:  
an electronic tag attached on or put in the certificate and storing a first  
information (Fig. 3, 17A,B; summary; Column 10 lines – 22 and Column 14 line 4 –  
Column 15 line 32);

wherein a second information and a digital signature are printed on the surface of  
the certificate (Fig. 3, 17A,B; summary; Column 10 lines – 22 and Column 14 line 4 –  
Column 15 line 32); and

the digital signature is generated from the first information and the second  
information (summary; Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line  
6).

Regarding Claim 19, Doggett teaches and describes a certificate comprising: an  
apparatus for issuing a certificate comprising:

a certificate paper-accommodating part which certificates comprising electric tags  
which accommodates stores first information (Fig. 3, 17A,B; summary; Column 10 lines  
– 22 and Column 14 line 4 – Column 15 line 32);

a printing part which prints a second information and a digital signature on the  
surface of the certificates Fig. 3, 17A,B; summary; Column 10 lines – 22 and Column  
14 line 4 – Column 15 line 32); and

wherein the digital signature is generated from the first information and the  
second information (summary; Column 7 lines 14 – 64 and Column 10 line 41 – Column  
11 line 6).

Claims 16 and 20 are rejected as applied above in rejecting claims 15 and 19. Furthermore, Doggett teaches and describes a certificate wherein the digital signature is generated from a linkage or a hashed linkage of the first information and the second information using RSA (Summary; Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line 6).

Claims 17 and 21 are rejected as applied above in rejecting claims 15 and 19. Furthermore, Doggett teaches and describes a certificate wherein the digital signature is a sum or a hashed sum of the first information and the second information using RSA (Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line 6).

Claims 18 and 22 are rejected as applied above in rejecting claims 15 and 19. Furthermore, Doggett teaches and describes a certificate wherein the first information is represented by  $x_1$ , the second information is represented by  $x_2$  and the digital signature is represented by  $y$ , secret keys are represented by  $d$  and  $n$ , and the digital signature is obtained by the equation  $y = (x_1 + x_2)^d \bmod n$ , where the function represents linking of  $x_1$  and  $x_2$  to each other (Column 7 lines 14 – 64 and Column 10 line 41 – Column 11 line 6).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yee et al. (U.S. Patent Number 5,781,723) System and Method for self-identifying a portable information device to a computing unit.

Aucsmith et al. (U.S. Patent Number 6,175,626) Digital certificates containing multimedia data extensions.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington, D.C. 20231 or

**faxed to:** (703) 872-9306 for all formal communications.

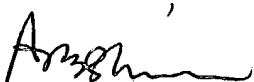
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 703-305-8912. The examiner can normally be reached on 8:00a.m. To 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Pramila Parthasarathy  
Patent Examiner  
703-305-8912  
October 8, 2004.

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100